

**REMARKS**

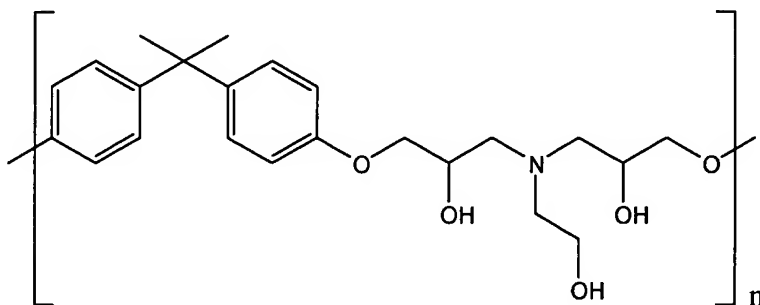
Applicant requests reconsideration and allowance of the present application in view of the foregoing amendments and the following remarks.

Claims 1, 2, 4-14, 16, 17, 19-21, 23, 24 and 26-28 are pending in the present application. Claims 1, 7, 11, 16, and 23 are the independent claims.

Claims 3, 15, 18, 22 and 25 have been cancelled without prejudice to or disclaimer of the subject matter recited therein. Claims 1, 7, 11, 16, and 23 have been amended. No new matter has been added.

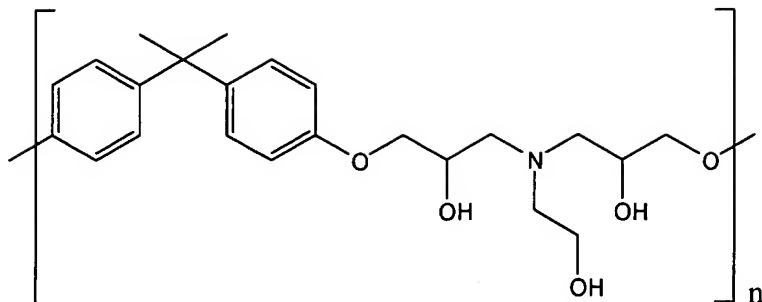
Claim 15 was rejected under 35 U.S.C. § 102(a) as being anticipated by U.S. Patent Publication No. 2002/0025184 (Ishikawa et al.). Claim 22 was rejected under 35 U.S.C. § 102(a) as being anticipated by U.S. Patent No. 6,689,522 (Yamazaki et al.). Claims 1, 2, 4-14, 16, 17, 19-22, 24, and 26-28 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,834,147 (Nagae et al.) in view of U.S. Patent Publication No. 2003/0148098 (Shafi et al.) and U.S. Patent No. 5,464,924 (Silvis et al.). Claims 1-28 were rejected under the judicially created doctrine of double patenting over claims 1-19 of copending Application No. 10/444,141. All rejections are respectfully traversed.

Claims 1 recites, inter alia, a composition for forming an overcoat layer including polyaminoether, the polyaminoether represented by the following formula, and being contained in an amount of 70 to 99 parts by weight based on 100 parts by weight of the solid content of an overcoat layer:



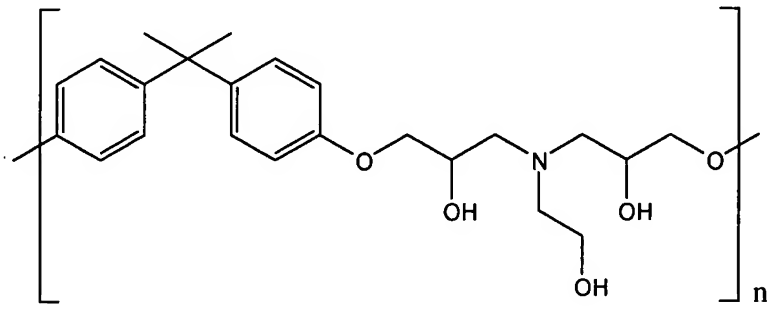
wherein n is an integer from 10 to 400.

Claim 7 and 11 recite, inter alia, a composition to be coated on a photosensitive layer, the composition including: a polyaminoether, the polyaminoether being represented by the following formula, and is contained in an amount of 70 to 99 parts by weight based on 100 parts by weight of the solid content of an overcoat layer:



wherein  $n$  is an integer from 10 to 400.

Independent claims 16 and 23 recite, inter alia, a composition to be coated on a photosensitive layer includes polyaminoether, the polyaminoether being represented by the following formula, and is contained in an amount of 70 to 99 parts by weight based on 100 parts by weight of the solid content of the overcoat layer:



wherein  $n$  is an integer from 10 to 400.

However, Applicants respectfully submit that none of Ishikawa et al., Yamazaki et al., Nagae et al., Shafi et al., and Silvis et al. teach or suggest at least the aforementioned features of independent claims 1, 7, 11, 16, and 23. Thus, while not conceding the propriety of the asserted combinations of these asserted citations, it is respectfully submitted that the asserted combinations of these citations are likewise deficient.

Nagae et al. relates to a photosensitive member for electrophotography and teaches using a protective layer to prevent damage to the surface of a photosensitive layer. (Nagae et al., Col. 2, lines 55-61). Silvis et al. relates to flexible poly(amino ethers) for barrier packaging and is cited for its alleged teaching of thermoplastic polyethers having pendant hydroxyl moiety protecting oxygen-sensitive materials. (Office Action, page 3). Shafi et al. relates to coating compositions, coated glass fibers and composites reinforced with the glass fibers and is cited for its alleged teaching of a poly(hydroxyl amino ether) and using methanol as a solvent. (Office Action, page 3). It is respectfully submitted that that none of Nagae et al., Shafi et al., and Silvis

et al. teaches or suggests at least the aforementioned features of independent claims 1, 7, 11, 16, and 23.

Regarding the rejections of cancelled independent claims 15 and 22, Ishikawa et al. relates to an electrophotographic cartridge image-forming method and an image-forming apparatus and describes an electrophotographic cartridge. Ishikawa et al. also discusses using a protective layer to improve electrical characteristics or mechanical characteristics of a photoreceptor. (Ishikawa et al., paragraph [0133]). Yamazaki et al. relates to an image forming method and electrostatic image developing toner and describes using a protective layer 5 laminated on a protective layer 6 of a photoreceptor. (Yamazaki et al., Col. 16, lines 10-20). It is respectfully submitted that Ishikawa et al. and Yamazaki et al. add nothing to the teachings and/or suggestions of the combination of Nagae et al., Shafi et al., and Silvis et al. that would remedy the aforementioned deficiency.

Accordingly, favorable reconsideration and withdrawal of the rejection of the features of independent claims 1, 7, 11, 16, and 23 under 35 U.S.C. § 103 are respectfully requested.

Regarding the provisional obviousness-type double patenting rejection, by separate paper filed concurrently herewith, Applicants have filed a terminal disclaimer disclaiming any patent term in excess of co-pending application no. 10/444,141.

In view of the foregoing, Applicant respectfully submits that the independent claims patentably define the present invention over the citations of record. Further, the dependent claims should also be allowable for the same reasons as their respective base claims and further due to the additional features that they recite. Separate and individual consideration of the dependent claims is respectfully requested.

Applicant believes that the present Amendment is responsive to each of the points raised by the Examiner in the Official Action. However, if there are any formal matters remaining after this response, The Examiner is requested to telephone the undersigned to attend to such matters.

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.


Serial No. 10/681,324

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

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